

## REMARKS

### SUMMARY:

The present application sets forth original claims 1-34, of which claims 1, 15 and 23 are independent claims. Amendments are submitted and requested entry for claims 15 and 22. The amendment to claim 15 is a clarifying amendment submitted to comply with a requirement of form such that specific language set forth in claim 15 is commensurate in scope with previously submitted arguments. The amendment to claim 22 is intended to correct an inadvertent typographical error relating to claim dependency. Neither amendment adds any new matter to the subject application.

Claims 2, 6-10, 12-14, 19-21, 27-30 and 32-34 are objected to, but have been indicated as allowable if rewritten in independent form to include limitations of the base claim and any intervening claims. Claims 1, 5, 11, 23, 26 and 31 stand rejected under 35 U.S.C §102(e) as being allegedly anticipated by U.S. Patent No. 6,587,327 (Devoe et al.) Original claims 15-16 stand rejected under 35 U.S.C §102(e) as being allegedly anticipated by U.S. Patent No. 6,594,136 (Kuroda et al.) Original claims 17-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kuroda et al. Original claims 3-4 and 24-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Devoe et al.

Responses to the rejections summarized above (including traversal of each prior art rejection) are hereafter provided with respect to each individual argument presented by the Examiner.

### REJECTION OF ORIGINAL CLAIMS 1, 5, 11, 23, 26 and 31 (35 U.S.C. §102(e)):

Original claims 1, 5, 11, 23, 26 and 31 stand rejected under 35 U.S.C §102(e) as being allegedly anticipated by U.S. Patent No. 6,587,327 (Devoe et al.) Based on the following remarks, Applicants respectfully traverse such alleged anticipation.

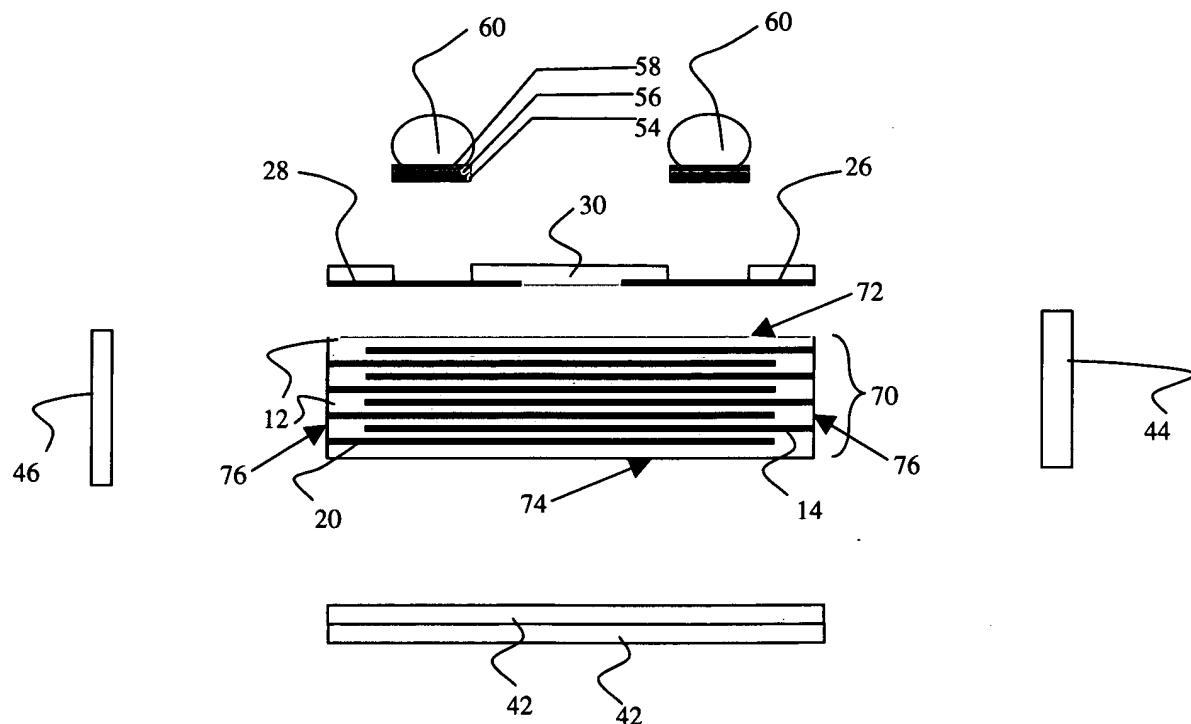
Before setting forth a discussion of the prior art patents applied in the recent Final Office Action, it is respectfully submitted that controlling case law has frequently addressed rejections under Sections 102.

"For a prior art reference to anticipate in terms of 35 U.S.C Section 102, every element of the claimed invention must be identically shown in a single reference." Diversitech Corp. v. Century Steps, Inc., 850 F.2d 675, 677, 7 U.S.P.Q.2d 1315, 1317 (Fed Cir, 1988; emphasis added). The disclosed elements must be arranged as in the claim under review. See Lindemann Machinefabrik v. American Hoist & Derrick Co., 730 F.2d 1452, 1458, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). If any claim, element, or step is absent from the reference that is being relied upon, there is no anticipation. Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 230 U.S.P.Q. 81 (Fed. Cir. 1986). Anticipation under 35 U.S.C. Section 102 requires that there be an identity of invention. See Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, \_\_\_, 225 U.S.P.Q. 635, 637 (Fed. Cir. 1985). In PTO proceedings, claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 U.S.P.Q. 385, 388 (Fed. Cir. 1983).

A discussion of present claim 1 will now be presented with respect to the below Figure A, which is a selectively exploded view of Figure 4A of the subject application. Elements set forth in present claim 1 are specifically explained relative to Figure A. It should be appreciated that the following discussion is provided only as a detailed example of one embodiment of the structure set forth in claim 1. It is not intended that Claim 1 be limited to only cover the description and features set forth relative to the exemplary embodiment of Figure A.

Claim 1 sets forth a multilayer electronic device including a plurality of dielectric layers (e.g., elements 12, 42 of Figure A), a plurality of electrode layers (e.g., elements 14 and 20 of Figure A), and at least one respective first and second transition layer electrode portion (e.g., elements 26 and 28 of Figure A). The plurality of electrode layers 14, 20 are interleaved with selected of the plurality of dielectric layers 12 to form a multilayered arrangement (e.g., indicated by new reference numeral 70) that is defined by first and second opposing surfaces (e.g., indicated by new reference numerals 72 and 74, respectively) and a plurality of side surfaces (e.g., indicated by new reference numerals 76; note that only two side surfaces of the multilayer electronic device are illustrated in Figure A since it is a two-dimensional view). The transition layer

electrode portions 26, 28 are provided on the first surface 72 of the multilayered arrangement 70. Furthermore, each electrode layer extends to and is exposed along at least one side surface 76 of the multilayered arrangement. A cover layer 30 is provided over the first and second transition layer electrode portions 26, 28 to define a plurality of openings therethrough for exposing a portion of transition layer electrode portions 26, 28. A first peripheral termination 44 is formed along selected side surfaces 76 of the multilayered arrangement 70 and electrically connects selected electrode layers 14 and first transition layer electrode portion 26. A second peripheral termination 46 is formed along selected side surfaces 76 of the multilayered arrangement 70 and electrically connects selected electrode layers 20 and second transition layer electrode portion 28.



*Figure A*

Numbered pages 2 and 3 of the March 18, 2005 Office Action set forth that Devoe et al. disclose all elements of claim 1. Applicants explained in the previous response filed December 28, 2004 how the subject matter of claim 1 differs from the

technology disclosed in Devoe et al. Applicants continue to submit that there are fundamental differences between claim 1 and the disclosure of Devoe et al., An elaboration of those differences will now be presented.

As described above with respect to claim 1, such claim sets forth a plurality of dielectric layers and a plurality of electrode layers that are interleaved to form a multilayered arrangement (depicted as element 70 in Figure A). Multilayered arrangement 70 is defined by first and second opposing surfaces 72 and 74, respectively. First and second transition layer electrode portions 26 and 28 are provided on the first surface 72 of the multilayered arrangement 70.

As indicated on page 10 of the March 18, 2005 Office Action, especially in the figure on page 10, the Examiner compares the multilayer arrangement of claim 1 to the entirety of upper capacitor section 60 and compares a first surface of such multilayer arrangement to be represented by the dividing line between upper capacitor section 60 and lower capacitor section 62. If this is what the Examiner refers to as the "first surface" of the multilayer arrangement, then the alleged transition layers of Devoe et al. (interior plates 66 and 68) are NOT provided on the surface of such arrangement. Instead, additional dielectric layers and another interior plate 76 are provided on the first surface defined as the separating line between capacitor sections 60 and 62 of Devoe et al.

In the same figure on numbered page 10 of the March 18, 2005 Office Action, there is an apparent contradiction in reference to an alleged multilayer arrangement and the first surface of such multilayer arrangement. If the multilayer arrangement as allegedly disclosed in Devoe et al. is to include the entirety of upper capacitor section 60 as well as the additional dielectric layers and interior plate 76 associated with lower capacitor section 62, then this contradicts the Examiner's statement on numbered page 9 of the March 18, 2005 Office Action that "The Examiner does not define the ... multilayer arrangement to include the floating interior plate".

But, as previously noted by Applicants, the only way that the allegedly equivalent transition layer electrode portions of Devoe et al. (namely, interior plates 66 and 68) can be provided on the first surface of the multilayered arrangement, is if the multilayered

arrangement is considered to include all plates 10, 11 and 76 as well as associated dielectric layers. Plates 10, 11 and 76 as disclosed in Devoe et al. are all considered to be capacitor plates. Claim 1 sets forth that all the capacitor plates (referred to in claim 1 as electrodes) extend to and are exposed on at least one side surface of the multilayered arrangement. If the multilayered arrangement does include plate 76 (which is also an electrode), then such element clearly does not extend to and is not exposed on any side surface of the device set forth in Devoe et al., as is required by claim 1.

The nature of open-ended claim language, such as the transitional phrase "comprising" used in claim 1, is fully appreciated. However, the interior plate 76 of Devoe et al. is not just some unrecited element. Interior plate 76 is an electrode layer just like plates 10 and 11 are electrode layers, and claim 1 requires that all electrode layers extend to and are exposed on at least one side surface. If an argument is made by the Examiner that interior plate 76 is not an electrode layer and is not included in the multilayer arrangement, then plates 66 and 68 (equated to transition layer electrode portions) respectfully are not applied to the first surface of the multilayered arrangement of Devoe et al.

As set forth above, Devoe et al. clearly fails to disclose all elements of claim 1, including the provision of at least one respective first and second transition layer electrode portion on the first surface of the multilayered arrangement and the provision of each electrode layer as extending to and exposed along at least one side surface of the multilayered arrangement. As established by the controlling case law, for a prior art reference to anticipate in terms of 35 U.S.C Section 102, every element of the claimed invention must be identically shown in a single reference. Further, if any claim, element, or step is absent from the reference that is being relied upon, there is no anticipation. For at least the reasons set forth above, Applicants submit that claim 1 cannot by law be anticipated by Devoe et al. Reconsideration of the alleged anticipation is respectfully requested.

With regards to claim 5, Applicants note that claim 5 depends from otherwise allowable present claim 1 and further limits same. Since the subject matter set forth in

claim 1 is allowable over Devoe et al. as established in the above arguments, claim 5 should also be allowed, and acknowledgement of the same is earnestly solicited.

With regard to claims 11 and 31, Applicants note that Devoe et al. do not disclose all elements of such claims. Present claims 11 and 31 respectively set forth that the at least one first and second peripheral terminations extend along an entire dimension of a respective selected side surface of the multilayer device and wrap around to at least one side surface adjacent to the respective selected side surface. Such side surfaces are different from the top and bottom surfaces of such device (as set forth in claim 1 – note that the top surface is the one on which transition layer electrode portions and the cover layer are provided thereon, while the bottom surface is opposite the top surface).

Devoe et al. disclose opposite side metallizations that extend from selected side surfaces and wrap around to top and bottom surfaces (as admitted by the Examiner on numbered page 11 of the March 18, 2005 Office Action), not to adjacent side surfaces as required by respective claims 11 and 31. Such terminations are provided in such a fashion to serve as lands for surface mounting the capacitor to traces on a circuit board (see Fig. 2A and corresponding description). Since Devoe et al. do not disclose peripheral terminations provided in such an orientation as set forth in claims 11 and 31, Applicants respectfully submit that present claims 11 and 31 are not anticipated by Devoe et al. and acknowledgement of the same is respectfully requested.

With regards to original claim 23, Applicants submit for reasons similar to those already set forth above relative to claim 1, that Devoe et al. fail to disclose all elements of such claim. As such, withdrawal of the anticipation rejection of such claim is respectfully requested. With regard to claims 26 and 31, Applicants note that such claims variously depend from otherwise allowable claim 23 and further limit same. Since the subject matter of claim 23 is allowable over Devoe et al. as established in the above arguments, claims 26 and 31 should also be allowed and acknowledgement of the same is earnestly solicited.

**REJECTION OF ORIGINAL CLAIMS 15-16 (35 U.S.C. §102(e)):**

Original claims 15-16 stand rejected under 35 U.S.C. §102(e) as being allegedly anticipated by U.S. Patent No. 6,594,136 (Kuroda et al.) Based on the following remarks, Applicants respectfully traverse such alleged anticipation.

The Examiner in the recent detailed action (on numbered pages 11 and 12) alleges that arguments made by Applicants with respect to claim 15 are not commensurate with the scope of such claim. More particularly, the Examiner noted with respect to the via terminations set forth in claim 15, that the claim language sets forth that first and second via terminations are respectively “electrically connected” to an electrode tab of one of said respective first or second electrode layers. The Examiner notes that the arguments presented in the last response by Applicants were based on an interpretation that the first and second via terminations are respectively “directly connected” as opposed to “electrically connected” to an electrode tab of one of said first or second electrode layers. In response, Applicants have included in the presently requested amendment to claim 15 a modification to affirm such claim recitation as “directly connected”. The revised claim language in claim 15 is intended to clarify that the claim language and the corresponding previous arguments are commensurate in scope, and are not intended to result in any other substantive effect with respect to scope.

Since the presently requested amendment to claim 15 complies with a requirement of form set forth in the previous office action for consideration of such claim in light of the arguments already presented, Applicants submit that such amendment complies with 37 C.F.R. §1.116(b). As such, Applicants request entry of the presently submitted amendment to claim 15, which is intended as simply clarification of claim language per the Examiner’s response in the March 18, 2005 Office Action. Applicants further note that the presently submitted amendment to claim 22 is intended to merely correct an inadvertent typographical error, and does not add any new matter to the subject application.

In light of the presently requested amendments and the previously submitted arguments regarding claims 15 and 16, Applicants respectfully request reconsideration of the alleged anticipation of such claims.

**REJECTION OF ORIGINAL CLAIMS 17-18 (35 U.S.C. §103(a)):**

Original claims 17-18 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Kuroda et al.

With regard to claims 17-18, Applicants note that such claims depend from otherwise allowable present claim 15 and further limit same. Since the subject matter set forth in claim 15 is allowable over Kuroda et al. as established in the arguments in the above section, claims 17-18 should also be allowed and acknowledgement of the same is earnestly solicited.

**REJECTION OF ORIGINAL CLAIMS 3-4 AND 24-25 (35 U.S.C. §103(a)):**

Original claims 3-4 and 24-25 stand rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Devoe et al.

Based on the arguments presented above with respect to present claim 1, Applicants submit that such claim should be allowed over Devoe et al. Since claims 3-4 variously depend from otherwise allowable claim 1 and further limit same, claims 3-4 should also be allowed. Acknowledgement of the same is earnestly solicited.

Similarly, based on the arguments presented above with respect to original claim 23, Applicants submit that such claim should be allowed over Devoe et al. Since claims 24-25 variously depend from otherwise allowable claim 23 and further limit same, claims 24-25 should also be allowed. Acknowledgement of the same is earnestly solicited.

**CONCLUSION:**

Inasmuch as all outstanding issues have been addressed, it is respectfully submitted that the present application, including claims 1-34, is in complete condition for issuance of a formal Notice of Allowance, and action to such effect is earnestly solicited. The Examiner is invited to telephone the undersigned at his convenience should only

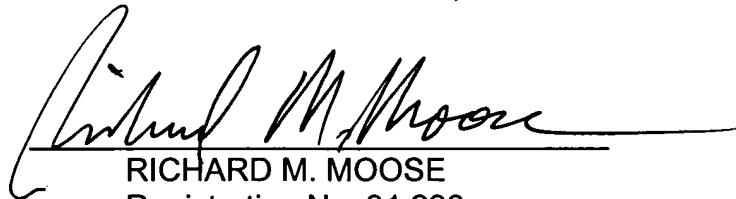
minor issues remain after consideration of this response in order to permit early resolution of the same or if he has any questions regarding this matter.

Respectfully submitted,

DORITY & MANNING,  
ATTORNEYS AT LAW, P.A.

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Date



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